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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.               |
|---|-------------|----------------------|---------------------|--------------------------------|
| 10/666,168  | 09/19/2003  | Phillip Martin Gibbs | 5490-000301         | 7099                           |
| 7590  | 06/21/2006  |                      |                     |                                |
| Stephen J. Foss<br>Harness, Dickey & Pierce, P.L.C.<br>P.O. Box 828<br>Bloomfield Hills, MI 48303 |             |                      |                     | EXAMINER<br>SNOW, BRUCE EDWARD |
|   |             |                      |                     | ART UNIT<br>3738 PAPER NUMBER  |

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                           |                     |  |
|------------------------------|---------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>    | <b>Applicant(s)</b> |  |
|                              | 10/666,168                | GIBBS ET AL.        |  |
|                              | Examiner<br>Bruce E. Snow | Art Unit<br>3738    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 April 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-13 and 35-50 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13, 35-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's amendments and arguments filed 4/3/06 have been fully considered.

The Examiner notes applicant's request for interview, however, it is moot because applicant has already submitted a formal response wherein the amendments and declaration have overcome all previous rejections. Additionally, supplemental amendments are no longer a matter of right.

The objection to the specification for failing to provide proper antecedent basis for the claimed subject matter has been withdrawn. Applicant's amendment adding the terminology "prosthesis" to claims 35 and 39 helped clarify the scope of the terminology.

The declaration filed on 4/3/06 under 37 CFR 1.131 is sufficient to overcome the Graf (WO 02/00141) reference.

Regarding the rejection in view of Donner, applicant amendments to independent claims 35 and 39 to include the terminology "prosthesis" overcame said rejection.

Applicant's amendment to claim 1 overcame the rejection in view of Gray, III.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 35-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Germany (DE 9312150, applicant submitted).

Claims 1-13 and 35-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Graf (US 2003/0153912).

Referring to all figures, specifically figure 4, Graf teaches a prosthetic joint for replacement of a natural joint to resist dislocation, the prosthetic joint comprising: a liner 22' including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

a ball portion 4 having a ball diameter substantially equal to said internal concave diameter, and a constraining ring 10' cooperating with said opening,

wherein said ball portion includes an equator 6 having an equator diameter similar to said passage width and smaller than said ball diameter;

wherein said ball portion is adapted to be implanted into said internal concave portion during an operative procedure.

All other claim limitations are self-evident.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 35-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noiles (4,978,356) in view of Germany (DE 9312150, applicant submitted).

Referring to at least figures 26-30, Noiles teaches a prosthetic joint for replacement of a natural joint to resist dislocation comprising:

a liner 12 including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

a ball portion having a ball diameter substantially equal to said internal concave diameter, and a constraining ring 120 cooperating with said opening,

However, Noiles is silent regarding said ball portion having a cylindrical equator having a diameter to said passage width.

Germany teaches a similar prosthetic joint for replacement of a natural joint to resist dislocation comprising ball 14 having a cylindrical equator 18. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Germany wherein the ball has a cylindrical equator with the ball of Noiles such that the liner, cup, and retaining ring could be pre-assembled when found desirable by the surgeon and the ball could easily enter the opening passage in an un-anatomical position and lock in an anatomical position within the liner.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

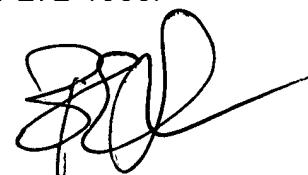
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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BRUCE SNOW  
PRIMARY EXAMINER